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EXAMINER

REICHLE, KARIN M

| ART UNIT | PAPER NUMBER |
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3761

DATE MAILED: 03/20/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/512,085

Applicant(s)

COATES, FREDRICA V.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002 and 9-30-02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-18 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 17-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 30 September 2002 is: a) ☒ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☐ Other:

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1. Claims 5-9 and 11-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected elected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 16.
2. Applicant's election with traverse of the species of Figures 1-1H in Paper No. 16 is acknowledged. The traversal is on the ground(s) that the examination of all the claims would not be burdensome. This is not found persuasive because the examination of the claims directed to 9 species would be burdensome. Furthermore, the election is based on the species being patently distinct which Applicant does not address.

The requirement is still deemed proper and is therefore made FINAL.

- 3 The drawings are objected to because the Figures are still replete with informalities. For example: Figures 2, 3, 4, and 7-9 are inconsistent with the description thereof on pages 3-6, i.e. partly cutaway. All the cross sectional lines, e.g., 1A-1A, etc. need to be denoted by Roman or Arabic numerals. The line from 10 should either be an arrow or the line should extend all the way to the structure it denotes in Figures 2, 3, 4. This applies to 50 in Figure 3A, 11 in Figures 5 and 6, 100 in Figure 7 and 14 in Figure 9 also. The line from 24 should be dashed to denote underlying structure in Figures 2-4. This applies to 110, 12A and 42 in Figures 7-9 also. In Figure 1F, 17A does not denote a stitch line as described at page 8, lines 17 et seq. In Figure 3F, 84 does not denote the stitching. Also Figure 4 does not show the sling of Figures 1-3 as described at page 11, last line. In Figure 4, 62A, 62C, 66A, 66C, 67A, 67C, and 67B, and 67C are not properly shown. In Figures 7A, numeral 50 should not be underlined and a line therefrom should extend to

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the structure it denotes. See discussion of the objection to the specification *infra* also. It should be noted that these examples are merely illustrative. Applicant should carefully review and revise, as necessary, all the Figures. Correction is required.

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 30, 2002 have been approved in part(Figures 1-1B only).

The drawings are not approved because they are inaccurate or inconsistent, see discussion of Figures 5 and 5B *infra*, e.g. the line from 404 should be dashed, the line from 404 in Figure 5A should not be dashed.

5. The use of the trademark Jockey in combination with the word "type" in the insert to page 12, line 11, which is improper has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. The disclosure is objected to because of the following informalities: The specification is replete with informalities. For example:

1) On page 4, line 16, where is line 3B-3B set forth? 2) In Figures 2, 3, 4, what is 100? 3) In Figure 1H, what is 43? 4) Is the insert to page 2 the Summary of the Invention? If so it should be preceded by such a subtitle. Also the insert includes grammar mistakes. This last comment also applies to the insert of page 3, line 4. 5) The description at page 7, lines 15-17, the insert at

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page 8, lines 1-2, and third paragraph, page 8, lines 16-17 and Figures 1D-1F with respect to the numerals 42, 21, 21A, 42A, 42B are inconsistent. For example, the numeral 42 is used to denote and describe three different structures which improper, i.e. it is used to describe the seam line and the edges of the removed corners and the smooth finished surface. For another example, the last sentence of the insert to page 8 is unclear as to what is being described. For a third example what are 42A and 42B? A clear consistent showing and description of the structure using consistent terminology and numerals should be set forth. 6) The description of Figures 2-2E on page 9, line 7-page 11, line 2 and Figures 2-2E are also inconsistent. For example, what are 64 and 65? For another example, Figure 2A is not a cross section along line 2A-2A because cuff 60 is at the end not the side. In Figure 2A 68 denotes the space not the sling and 20 does not denote the stitching. Where is 62 in Figure 2A? In Figure 2, the edges 61B and 71 and seamline 71A, as best understood, are interior of the pocket but are not denoted as such. The numeral 71 is used to denote both the edge and the seamline A. In Figure 2C, 60 and 61 do not denote the cuffs which are described as being of folded material. The stitching 70 in Figures 2C-2E and that in Figure 2 is shown differently. 7) The description at page 11, lines 5-7 and 10, i.e. alternative use of Velcro and snaps, and Figures 3 and 3A are inconsistent. Again a clear consistent showing and description of the structure using consistent terminology and numerals should be set forth. 8) The remarks with regard to 6) supra also apply to the same structure shown and described with respect to Figures 4-4B. 9) The description in the second sentence of the insert to page 13, lines 3-6 is unclear, i.e. what structure is Applicant trying to describe? On page 13, line 8, "as" should

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be deleted. 10) The description at page 12, line 11-page 14, line 15 and Figures 5-6B are inconsistent. For example, the numeral 162 and 163 are used to describe different structures in Figures 5-5B and 6-6B. A consistent clear showing and description of the structure using consistent terminology and numerals should be set forth. 11) The description on page 14, line 16-page 16, last line, Figures 7-9 and Figure 1 are inconsistent. For example, the numeral 42 is used to denote more than one structure and not the same structure as in Figure 1. For another example, where is 43 shown? 12) It should be noted that these examples are merely illustrative. The entire specification should be carefully reviewed and revised, as necessary.

Appropriate correction is required.

7. Claims 2-3, 10 and 17-18 are objected to because of the following informalities: In claims 2-3, 10 and 17-18, line 1, "A" should be --The--. In claim 10, line 2, "with" should be deleted, line 3, after "pocket", --having been -- should be inserted, after ",", --and-- should be inserted and "are" deleted. Appropriate correction is required.

8. Claims 1-3, 10 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, the use of the terminology "outer"(line 2), "inner"(line 6), "inward"(line 7), and "outwardly"(line 8) is confusing because the first two appear to use the body as a frame of reference, i.e the inner layer is closer to the wearer during use than the outer layer, yet the last two seem to use something else as a reference. A clear consistent use of the

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terminology should be set forth. For purposes of examination, the sides will be considered as being laterally displaced towards the center of the anchor layer whereas the inner layer will be considered to extend inwardly or raise from the anchor layer.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Brownlee et al. See Figures, especially Figures 7-8, col. 2, lines 25-34 and col. 4, lines 52-59, e.g. outer layer and anchor layers are plies of body 12, also note Figure 10, and col. 4, line 59-col. 5, line 14, i.e the inner layer of fluid resistant material is 108 which has all its sides 117, 118 and panels 132 attached to the anchor layer, directly by stitching 127 and 129 and indirectly by welds 123, 125 and stitching 133, the sides being displaced inwardly, see Figure 7, from sides of the anchor layer and extending outwardly therefrom to form a pocket, see Figures 7-8. With regard to claims 2-3 and 17-18, see portions cited above, i.e base is 109, stitching is 127, 129 and stitching 133 interconnects sides.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brownlee.

This claim recites a product by process. As set forth in MPEP 2113 the patentability of such claims are based on the product itself not the method of production. If the end product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. As best understood due to the breadth of the claimed process, i.e. doesn't set forth the size or orientation of the triangular portions or how the sides are joined, e.g. over lapping, abutting etc., the end product by the claimed process is the same as or obvious from the Brownlee device.

13. Applicant's remarks have been considered but are either deemed nonpersuasive in that they have not been reraised or are deemed nonpersuasive for the reasons set forth above. With regard to Applicant's remarks with regard to the prior art, such remarks have been considered but are deemed narrower than the teachings of Brownlee since Brownlee teaches more than one embodiment, see rejection supra.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other references teach various pockets.

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15. Any inquiry concerning this communication should be directed to K. Reichle at telephone number (703) 308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFAX number is 703-872-9302.

K. Reichle
March 14, 2003

K. Reichle
KIM REICHEL
PATENT EXAMINER